

REMARKS

This Amendment is submitted preliminary to the issuance of an Office Action in the present application and in response to the Official Action of June 10, 2010.

Claims 1-29 are in the application. Claims 1-7 and 22-28 are currently withdrawn from consideration. Claim 18-21 and 29 were examined.

Claims 18-21 and 29 are rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement.

Claims 18-21 and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WO99/155117 to Mao *et al.* ("Mao").

REJECTION OF CLAIMS 18-21 AND 29 UNDER 35 U.S.C. §112, FIRST PARAGRAPH

The Examiner's rejection is based on the failure by applicant to point to support for the definition of R_1 which was inserted into claim 18. Applicant points out that support for the definition is given in claim 1 and 13 as originally claimed. In addition, the definition is disclosed in detail on pages 2- 3 of the specification, notably paragraphs [0007]-[0013].

With respect to the Examiner's request to explain "at least one of", applicant points to the instance where the original claim recites "or/and" or "and/or" which means "at least one of A and B" thus fulfilling the permutation that is encapsulated in the "and/or" phrase.

With respect to the amendment of June 7, 2006 regarding paragraph [0005], the Examiner considered to be "new matter", even though applicant considered this to be simply a clearer way of expression, applicant has amended the paragraph to delete the offensive phrase so it reads as it was originally submitted, to avoid the "new matter" rejection.

Based on the foregoing, applicant has eliminated all grounds for the rejection under 35 U.S.C. §112, first paragraph.

Withdrawal of the rejection of claims 18-21 and 29 under 35 U.S.C. §112, first paragraph is respectfully requested.

REJECTION OF CLAIMS 18-21 AND 29 UNDER 35 U.S.C. §103(a) OVER THE MAO REFERENCE

The Examiner cites compounds of the reference as allegedly teaching structurally similar dyes that embrace applicant's claimed invention. The specific wording the Examiner applies here clearly indicates that the Mao compounds are different. Furthermore, to support her rejection, the Examiner points "*especially compounds on page 5, table 1, examples and claims*" Applicant points out that there is not table 1 on page 5 of the Mao reference. Applicant surmises therefore that the Examiner refers to the table set forth on page 8 of the document. Since the Table 1, spanning pages 8-10 contains 10 compounds of varying structure, it would be helpful if not proper for the Examiner to point out the specific compounds to which the Examiner refers.

However, in the spirit of efficiency, applicant hereby submits an amendment to claim 18 in which X is now defined as selected from the group of halogen, -O-R₉, -S-R₁₀ and -NR₁₁R₁₂ and where the OH group has been deleted. The amendment to claim 18 overcomes the Examiner's rejection based on Mao. The Mao reference discloses only dyes having the sulfite residue group -SO₃X, where X is hydrogen or an opposite ion such as e.g. lithium. With the present amendment, the compounds of claim 18 as presented patentably distinguish from the compounds of Mao.

In view of the above, each of the presently pending claims in this application is considered patentably differentiated over the prior art of record and believed to be in immediate conditions for allowance. Reconsideration and allowance of the present application are thus respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the

Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

By: 

Ursula B. Day
Attorney for Applicant
Reg. No. 47,296

Date: October 6, 2010
708 Third Avenue
Suite 1501
New York, N.Y. 10017
(212) 244-5500
UBD:pn